REMARKS

Applicant responds to the September 9, 2008 Decision on Appeal with the following remarks presented according to the Board's communication.

Status of Claims

Claims 1 – 5, 7 - 15 and 17 – 20 are pending in this application. Claims 1 and 11 are herewith amended. Support for the amendments is found throughout the specification. No new matter is presented by the amendments. Claims 10 and 20 are herewith canceled. Accordingly, Applicant respectfully requests entry thereof, and consideration of claims 1 – 5, 7 – 9, 11 -15 and 17 – 19 in light of the above amendments and the following remarks.

Claim Rejections - Rejection under 35 U.S.C. § 103

Claims 1 and 11 have been rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,493,677 to von Rosen ("Rosen") in view of Bittel, Lester Robert (Ed.), Encyclopedia of Professional Management, ISBN 0-07-005478-9, pp. 739 and 958 (1978) ("Bittel"). This rejection is respectfully traversed. The rejections against the pending claims under consideration should be withdrawn for at least the reasons set forth below. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Rosen in view of Bittel fail to disclose all of the recited elements of independent claims 1 and 11.

Rosen appears to be directed to a method and apparatus for creating and ordering customized branded merchandise over a computer network. Bittel appears to discuss the need for parts standardization and the problems associated with developing "a good parts-number coding system," (Bittel, p. 739). Neither Rosen nor Bittel teach a system and method for

configurating one or more products where a price for a customizable product is dynamically generated using user-customizable pricing data and formulas based in part on item, process, and artwork parameters. Additionally, neither Rosen nor Bittel teach a system and method for configurating one or more products where products may be divided into items and processes, wherein item and process parameters may be separately specified and linked together to create a unique product where a product identifier may be dynamically created when the product is sourced, quoted, ordered or otherwise accessed (*see* Paragraph [0031]).

In contrast, Claims 1 and 11 recite "dynamically generated using user-customizable pricing data and formulas based in part on the item, process, and artwork parameters." The present invention has the advantage of providing a user with pricing information that takes into account a large multitude of factors including, e.g., the desired materials to be used, the actual item to be customized, the nature of the stitching, and even the size and complexity of the artwork (*see*, *e.g.,* Paragraph [0029]). This provides the consumer with an exact price for their product based upon the nearly infinite possible combinations of product, process and materials. Further, the invention cuts out the "middle man" by allowing the consumer to interact directly with manufacturers. Rosen, however, merely appears to describe a system whereby a *single static price* is applied to the cost of a product *regardless* of what image or artwork is actually used. As the Board correctly noted, "[T]here is no discussion of price or of how a price is derived in von Rosen's specification," (Decision on Appeal at 10).

The differences between Rosen and the present invention are highlighted when Rosen is viewed in light of Bittel. The Decision on Appeal states that Bittel "shows that it was known the pricing algorithms had to produce prices that exceeded the full cost of what was sold." (Decision

on Appeal at 13). However, it is respectfully submitted that analogizing this general business tenant to the present invention disregards its novel combination of elements. As discussed above, the pricing algorithm of the present invention dynamically takes into account product and process attributes to produce an end price directly to the consumer from a potentially unlimited amount of manufacturers and other vendors. Bittel is silent on this point.

Moreover, if one skilled in the art combined the teachings of Rosen with Bittel, the end result would be a system that included nothing more than a markup of the static price of Rosen's product.

Independent claims 1 and 11 also require ***linking identified item parameters, process parameters and artwork parameters to dynamically create a product identifier when the product is sourced, quoted or ordered***. Claims 1 and 11 further recite that the product identifier is defined by ***a combination of the product's item parameters, process parameters, and artwork parameters***.

The disclosure of Rosen provides no discussion of product identifiers. Rosen is directed to creating and ordering customized branded merchandise but fails to provide any meaningful discussion of product identifiers that relates in any way to the claimed dynamic creation of a product identifier when the product is sourced, quoted, or ordered. The Decision on Appeal relies primarily on Bittel to show that "a good parts numbering system was an element in modern materials management systems," (Decision on Appeal at 12). However, Bittel merely states that "one of the key materials management issues concerns itself ***with the problem of parts and materials standardization***," (Bittel at p. 739). Bittel does not teach nor suggest any solution to

this problem, nor how to create a "good parts numbering system" in relation to customizable products.

In one embodiment of the present invention, SKUs may be dynamically generated based on possible combinations of a product's identified item parameters, process parameters, and artwork parameters. For example, a product may be a branded T-shirt with many customizable attributes. The fabric of the T-shirt may be sold by a vendor by the square yard and/or fabric type (e.g., cotton, polyester, a blend, etc.). Traditionally, each combination of length or fabric type may have its own SKU, resulting in thousands of SKUs. The vendor may further sell T-shirt fabric in a variety of colors, each color having its own SKU. Thus, the thousands of possible SKUs representing combinations of length and fabric type must then be multiplied by millions of possible SKUs for possible colors. Further, customizable process parameters and artwork parameters may be chosen by a customer, resulting in an exponential increase in potential SKUs. Oftentimes, a vendor (or distributor) may attempt to define all possible product SKUs when presenting promotional products options to a customer. This creates inefficiencies and duplicated efforts because the actual, branded product does not become a SKU until the item and process are combined. Rosen in view of Bittel do not teach nor suggest a standard method of identifying promotional products because they are so varied and numerous.

The present invention addresses this problem. Independent claim 1 is directed to a computer implemented method and system for configuring one or more products where products may be divided into items and processes ***wherein item and process parameters may be separately specified and linked together to dynamically create a unique product identifier when the product is sourced, quoted, ordered or otherwise accessed***. Moreover, the claim 1

recites that the product identifier ***is defined by a combination of the product's item parameters, process parameters, and artwork parameters***. According to an embodiment of the present invention, a product (e.g., the branded T-shirt discussed above) indicates product parameters (e.g., cotton/polyester blend, red color, size large), a process (e.g., embossing) is assigned a process parameter, and artwork (e.g., colored logo) is assigned an artwork parameter. The product identifier is dynamically created by linking these product parameters, process parameters, and artwork parameters, and the combination of these parameters define the product identifier. Likewise, independent claim 11 recites linking means for linking the item parameters, the process parameters and the artwork parameters and creating means for dynamically creating a product identifier when the product is sourced, quoted or ordered, where the product identifier is defined by a combination of the product's item parameters, process parameters, and artwork parameters. These claimed features, among others, are completely missing in Rosen in view of Bittel.

Notwithstanding the shortcomings of the Bittel reference discussed previously, it is well beyond the grasp of one skilled in marketing to combine the process in Rosen with the general statement in Bittel to arrive at the present invention. The Board's decision implies that a person of ordinary skill in the art of the invention is someone possessing expertise in all areas of materials management as well as marketing and business administration. This broad interpretation ignores the intended user and the core purpose of the invention: to provide a valuable bridge between marketing personnel and the manufacturers of promotional goods. The present invention incorporates several key features, including a pricing algorithm and the SKU generator discussed above. These features allow the user, possessing the ordinary skill of a

marketer/promoter, to be able to obtain remarkably accurate pricing data without having to be an expert in the field of materials management and/or advanced economics. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious *unless its actual application is beyond his or her skill.*" *KSR v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (emphasis added). Here, it is well beyond the skill of a marketer to be able to apply the requisite advanced business skills and supply-chain knowledge to arrive at a solution to the pricing and inventory problems outlined in Bittel.

The Decision on Appeal merely relies on Bittel's discussion of the problems associated with product code standardization to meet the product identifier claim limitation of claims 1 and 11, without any consideration to the claimed features that determine the product identifier. Applicant contends that Bittel fails to implement a system for ***dynamically*** creating a product identifier wherein ***the product identifier is created by linking the item, the process and the artwork parameters, where a combination of the item parameters, process parameters and artwork parameters defines the product identifier***. Bittel's discussion of product code standardization is not based on the claimed parameters.

Furthermore, the Decision on Appeal fails to set forth any motivation as to why one of ordinary skill in the art would have been motivated to modify the Rosen reference with Bittel. In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As discussed above, Bittel points to the need for product identification and merely suggests that a "good parts-number coding

system" is required in a materials management system. However, Bittel does not teach nor suggest any method or system for dynamically generating product identifiers for customizable products. Accordingly, one of ordinary skill in the art would not look to Bittel to solve the problem of dynamically creating product identifiers for customizable products.

Since Rosen in view of Bittel fail to disclose the recited elements of independent claims 1 and 11, Applicant respectfully requests the Examiner to withdraw this rejection.

Dependent claims 2-5, 7-9, 12-15 and 17-19 are Each Separately Patentable over Rosen in view of Bittel

The remaining claims depend ultimately from independent claims 1 and 11 and, as such, contain the features recited in claims 1 and 11. As discussed above, the proposed combinations fail to suggest or disclose each feature recited in claims 1 and 11 and, therefore, also fails to suggest or disclose at least these same features in the dependent claims. For at least this reason, Applicant respectfully submits that the rejections of the pending claims are improper and request that they be withdrawn. Additionally, these claims are separately patentable over the proposed combination of references for at least the reasons stated above.

Conclusion

In view of the foregoing, Appellant respectfully requests that the Examiner withdraw the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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